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EXAMINER
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WU, JERRY

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAMES E. McGUIRE, JR.

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Appeal 2015-001306  
Application 13/096,712  
Technology Center 2800

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Before MAHSHID D. SAADAT, NORMAN H. BEAMER, and  
MICHAEL M. BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–11, 13, and 22–26, which constitute all the pending claims.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellant identifies the real party in interest as enrotech, inc. App. Br. 4.

<sup>2</sup> Claims 12, 14–21, and 27 have been withdrawn. Final Act. 1, App. Br. 6.

### *Introduction*

Appellant states the claimed “invention relates generally to hard disk drives with integrated mechanisms for coupling of the hard disk drive within a computing environment and related methods.” Spec. ¶ 2. Claim 1 is illustrative (disputed requirements in *italics*):

1. A hard disk drive comprising  
a housing comprising a base, a cover, and *at least one integrated coupling mechanism within a non-metallic portion of the housing for coupling of the hard disk drive within a hard disk drive rack assembly* within a computing environment;  
at least one disk for storage of data enclosed within the housing;  
and  
one or more electrical components enclosed within the housing for facilitating reading and recording of data at a desired location on the at least one disk contained within the housing.

App. Br. 47 (Claims App’x).

### *References and Rejections*

Claims 1–9, 11, and 22–25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Applicant Admitted Prior Art (AAPA), Stefansky (US 6,226,143 B1; May 1, 2001), and Chen (US 2005/0237708 A1; Oct. 27, 2005). Final Act. 3–5, 7–9.<sup>3</sup>

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<sup>3</sup> Although the rejection of claims 22–25 refers to “Chen and “Chen2,” based on the Examiner’s citations, these are the same reference. *See* Final Act. 8; *see also* App. Br. 41 n.3.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over AAPA, Stefansky, Chen, and ENDO (JP 06-218799; Aug. 9, 1994). Final Act. 6.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over AAPA, Stefansky, Chen, and Tomizawa et al. (US 2006/0139873; June 29, 2006). Final Act. 7.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as unpatentable over AAPA, Stefansky, Chen, and Repphun et al. (US 5,559,650; Sept. 24, 1996). Final Act. 5–6.

### ISSUES

The issues before us are whether the Examiner errs in the rejections of claims 1, 6, 10, 13, 22, and 26.<sup>4</sup> *See* App. Br. 17–45.

### ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s contentions of reversible error. We disagree with Appellant’s conclusions. Unless noted otherwise below, we adopt the Examiner’s findings and reasons as set forth in the Final Rejection from which this appeal is taken and as set forth in the Answer. We highlight the following for emphasis.

#### *Claim 1*

Appellant argues that because Stefansky teaches hard disk housings that are unsuitable for mounting in a rack assembly, the Examiner errs by

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<sup>4</sup> Appellant argues (a) the patentability of dependent claims 2–5, 7–9, and 11 solely based on their dependencies from claim 1 (*see* App. Br. 12–16) and (b) claims 22–25 together as a group (*see id.* at 41–45), from which we select claim 22 as representative (*see* 37 C.F.R. 41.37(c)(1)(iv)). Except for our final disposition, we do not further discuss *infra* claims 2–5, 7–9, 11, and 23–25.

combining Stefansky's teachings with the rack-mountable hard disk teachings of AAPA and Chen. *See* App. Br. 12–16. Specifically, Appellant contends: (a) “Stefansky teaches away from such mounting configurations encompassed by AAPA and Chen” (*id.* at 14); (b) because AAPA and Chen teach rack mounting “by way of screws positioned in side walls of the hard disk drive housing” whereas Stefansky requires mounting “support posts on the bottom wall of the housing” (*id.* at 15), an ordinarily skilled artisan would not have combined the references' teachings as proposed by the Examiner; and (c) in view of the “contrasting teachings of AAPA and Chen as compared to Stefansky,” an ordinarily skilled artisan would not have had a reasonable expectation of success in making the combination. *Id.* at 16.

Appellant's arguments do not persuade us. A teaching away requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). “[T]hat two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another.” *Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004). “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Here, Stefansky teaches it was known in the art for hard disk drives to include non-metallic housings for coupling of the hard disk drive to other components (*see* 5:48–6:60, Fig. 1), which provides benefits such as reduced weight (*see* 3:43–51). Appellant does not identify any disclosure in

Stefansky that discredits rack mounting or otherwise would discourage an ordinarily skilled artisan from considering and adapting its teachings for use with prior art directed to rack mounting of hard disks, such as AAPA or Chen. Stefansky's silence regarding rack mounting issues does not amount to a teaching away from the requirements of claim 1. Instead, as the Examiner finds, and we agree, based on considerations of weight, size, and manufacturability, an ordinarily skilled artisan would have been motivated to use plastic housing material as taught by Stefansky with the hard disk housing taught by AAPA. *See* Final Act. 3–4, Ans. 4–5.

Although Chen and AAPA teach rack mounting by screws in the side walls of the housing, whereas Stefansky teaches mounting supports on the bottom wall of its housing not intended for rack mounting, our analysis remains unchanged. The Examiner simply relies on Stefansky for teaching a non-metallic housing material suitable for, *inter alia*, external coupling of a hard disk, and combines this teaching with AAPA's and Chen's teachings of a hard disk drive structure that includes screw holes in the sides for rack mounting. *See* Ans. 4. In other words, the Examiner relies on AAPA and Chen, not Stefansky, for teaching the recited requirement to “coupl[e] the hard disk drive *within a hard disk drive rack assembly*.”

Regarding expectation of success from the combination, Appellant provides no persuasive argument or evidence that using plastic housing components as taught by Stefansky for the disk drive housings taught by AAPA was “uniquely challenging or difficult for one of ordinary skill in the art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007)). Absent such an assertion, we “take account of the inferences and creative

steps that a person of ordinary skill in the art would employ,” and find a person of ordinary skill in the art would overcome any such difficulties within their level of skill. *KSR*, 550 U.S. at 418 (2007); see also *id.* at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”). We agree with the Examiner that this combination is “a simple substitution of one known element for another to obtain predictable results” of the type that *KSR* found to be obvious. *See* Ans. 5.

Accordingly, we sustain the rejection of claim 1.

*Claim 6*

Claim 6 depends from claim 1 and recites “wherein the cover comprises the integrated coupling mechanism.” App. Br. 47 (Claims App’x). Similar to claim 1, Appellant argues *Stefansky*, which teaches integrated mounting posts in the base (rather than the cover), “clearly teaches away from” claim 6. App. Br. 40; *see also id.* at 39–40. For the same reasons discussed *supra* for claim 1, we find Appellant’s arguments for claim 6 unpersuasive. Accordingly, we sustain the rejection of claim 6.

*Claim 10*

In rejecting claim 10,<sup>5</sup> the Examiner finds *ENDO*, in combination with *AAPA*, *Stefansky*, and *Chen*, teaches the recited requirement “wherein the female-type connector comprises a threaded bore.” Final Act. 6. Appellant argues the Examiner errs because “[t]he threaded bore of *ENDO* is not taught or suggested to be for securing an integrated coupling mechanism within a non-metallic portion of a housing for coupling of the

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<sup>5</sup> Claim 10 depends from claim 9, which recites “[t]he hard disk drive of claim 1, wherein the integrated coupling mechanism comprises a female-type connector suitable for engagement with a male-type connector.” App. Br. 48 (Claims App’x).

hard disk drive within a hard disk drive rack assembly.” App. Br. 28. This argument does not persuade us, because Appellant argues the Examiner errs based on limitations from claim 1 for which the rejection relies on AAPA, Stefansky, and Chen. *See* Final Act. 6. One cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references. *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (each reference cited by the Examiner must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole); *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Accordingly, we sustain the rejection of claim 10.

#### *Claim 13*

Claim 13 adds the requirement “wherein the integrated coupling mechanism comprises an elastomer” to claim 1. App. Br. 49 (Claims App’x). The Examiner finds Tomizawa, in combination with AAPA, Stefansky, and Chen, renders claim 13 obvious. Final Act. 7. Appellant argues the Examiner errs because “the buffer member of Tomizawa is not an integrated coupling mechanism according to the invention and as recited in claim 1.” App. Br. 33; *see also id.* at 33–34. We find this argument that Tomizawa does not teach claim 1 requirements for which the rejection relies on AAPA, Stefansky, and Chen unpersuasive for the same reasons discussed *supra* for claim 10. Accordingly, we sustain the rejection of claim 13.

#### *Claim 22*

Claim 22 recites “[a] hard disk drive rack assembly, wherein the rack assembly comprises at least one of the hard disk drives of claim 1.” App. Br. 50 (Claims App’x). Appellant repeats the arguments of Examiner error made previously for the rejection of claim 1. *See* App. Br. 41–45. For the



reasons discussed *supra* for claim 1, we find these arguments unpersuasive. Accordingly, we sustain the rejection of claim 22.

*Claim 26*

In rejecting claim 26, the Examiner finds Repphun, in combination with AAPA, Stefansky, and Chen, teaches the recited requirement “wherein the integrated coupling mechanism is secured within the housing using an adhesive” added to claim 1. Final Act. 5–6. Appellant argues the Examiner errs because “[n]ot one of the referenced uses of adhesive within Repphun is for securing an integrated coupling mechanism within a non-metallic portion of the housing for coupling of the hard disk drive within a hard disk drive rack assembly within a computing environment.” App. Br. 22; *see also id.* at 21–22. This argument does not persuade us for the same reasons discussed *supra* for claims 10 and 13. Accordingly, we sustain the rejection of claim 26.

DECISION

For the above reasons, we affirm the rejection of claims 1–11, 13, and 22–26. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED